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09/659,428	09/08/2000	Chhedi Lal Verma	FRB208	2946

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Horst M Kasper
13 Forest Drive
Warren, NJ 07059

EXAMINER

MEINECKE DIAZ, SUSANNA M

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 12/31/2002

14

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/659,428

Applicant(s)

VERMA ET AL.

Examiner

Susanna M. Diaz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed (on December 12, 2002) in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 21, 2002 has been entered. (Please note that the Applicant did not include a submission with the Request for Continued Examination paperwork; therefore, the After Final amendment filed on October 21, 2002 has been constructively considered to be Applicant's submission, which is necessary to file a proper RCE.)

Claim 19 has been amended.

Claims 11-27 are pending for examination.

2. The Applicant's substitute declaration received on October 21, 2002 overcomes the previously pending objection to the declaration.

Figures 1-5 have been received; however, Figure 6 is still missing. Please send in Figure 6.

The previously pending rejection under 35 U.S.C. 112, 2nd paragraph, is withdrawn in response to Applicant's amendment of claim 19.

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3. Applicant requests clarification of the location of the embedded hyperlinks in the specification. They are found throughout the first paragraph on page 3 of the specification and include the following: www.compare.net, www.bottomdollar.com, www.top10guide.com, www.shoppingexplorer.com, www.shopfind.com, www.roboshopper.com, www.jango.com. Please remove these hyperlinks from the specification.

Response to Arguments

4. Applicant's arguments filed October 21, 2002 have been fully considered but they are not persuasive.

Applicant's arguments are deemed to be non-persuasive for the reasons outlined in the previous Office action (paper no. 8).

Furthermore, Applicant argues:

Applicants respectfully submit that ZiffDavis and NetDynamics agree not to provide any price comparison between local stores and they also agree not to direct a buyer to a local store of the choice of the buyer.

Applicants respectfully submit that where two references agree not to do what applicants claim, then any combination of such references will be even less suggestive of the disclosure and claims of the applicants. (Page 6 of Applicant's Response filed October 21, 2002)

Applicant makes an assertion without any support for this assertion. For example, it is not clear where ZiffDavis and NetDynamics allegedly "agree not to provide any price comparison between local stores and they also agree not to direct a

buyer to a local store of the choice of the buyer.” Applicant’s argument is not persuasive.

Applicant argues that “Ziff-Davis does not address sorting of the information. The proposed patent explicitly sorts the information relative to products” (Page 9 of Applicant’s Response filed October 21, 2002). In order to present product information retrieved from a database (as taught by Ziff-Davis and discussed in the art rejection), product information must inherently be sorted. This is how database search and retrieval works.

Applicant argues that “Ziff-Davis does not address presenting the information. The proposed claim explicitly presents the information in a plurality of records to the prospective buyer” (Page 10 of Applicant’s Response filed October 21, 2002). As stated in the art rejection, Ziff-Davis teaches the provision of “side-by-side product comparisons” (¶ 12). The phrase “side-by-side” implies a visual presentation of these product comparisons.

Applicant argues that “Ziff-Davis does not disclose the type of information being collected [in claim 12]” (Page 11 of Applicant’s Response filed October 21, 2002). The Examiner notes that the information collected in claim 12 is listed in the alternative; therefore, only one element of each list needs to be addressed in order to adequately

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apply art to the claims. This burden has been met by the Examiner, as explained in the art rejection.

As per claim 12, Applicant argues that "Ziff-Davis does not disclose anything about entering attributes into a search key" (Page 11 of Applicant's Response filed October 21, 2002) and "Ziff-Davis does not disclose anything about types of attributes that are entered into a search key" (Page 12 of Applicant's Response filed October 21, 2002). The Examiner respectfully disagrees. Since customers can search Ziff-Davis' database by product category, a search key based at least on product category is inherent to Ziff-Davis. Furthermore, since Ziff-Davis provides "side-by-side product comparisons," this means that Ziff-Davis' database may be sorted at least by product name.

Applicant argues:

...While Ziff Davis provide product and price comparison, they expressly say in paragraph 4 that they guide the shopper through the entire buying process. This clearly expresses that according to Ziff-Davis nothing is to be added to the buying process of Ziff-Davis and it is respectfully urged that the person of ordinary skill in the art better accept the suggestion in Ziff-Davis that Ziff-Davis guides users through the entire buying process and that nothing else and in particular no NetDynamics features are needed. (Page 15 of Applicant's Response filed October 21, 2002)

Applicant's assertion that Ziff-Davis "[guides] the shopper through the **entire** buying process" and therefore it would not have been obvious to modify Ziff-Davis is

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erroneous. Most inventions arise from improvements over existing, prior art inventions. There is no requirement that the prior art disclosure explicitly state that the described invention **can be** modified in order to use such a disclosure as part of a 103(a) rejection. The Examiner maintains that one of ordinary skill in the art at the time of Applicant's invention would have found it obvious and been motivated to combine the teachings of Ziff-Davis and NetDynamics to yield the claimed invention for the reasons already outlined in the art rejection.

Applicant argues that "it is not understood where the suggestion comes from to sort according to price and it is believed that it is clear hindsight in view of applicants' invention" (Page 16 of Applicant's Response filed October 21, 2002). The art rejection states:

Ziff-Davis does not expressly disclose the sorting of its product database by price. The Examiner asserts that price is often a factor taken into account when customers shop for products that meet their needs; therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to sort Ziff-Davis' product database according to price in order to allow customers to more quickly narrow down their product selections to a more reasonable set of products that are the most likely to fit their needs (including their economic needs).

The suggestion to combine teachings (e.g., Official Notice with Ziff-Davis) comes from knowledge generally available to one of ordinary skill in the art at the time of Applicant's invention.

Applicant argues:

Applicants take exception, the indication of a state abbreviation clearly will in most cases not indicate local availability. Nobody in Buffalo would consider New York City local and nobody in San Francisco would consider San Diego to be local. Apart from that, neither Ziff-Davis nor NetDynamics employ the State abbreviation for directing to local merchants, this is solely the concept of the present Examiner. (Page 17 of Applicant's Response filed October 21, 2002)

First, if Applicant's assertion that "the indication of a state abbreviation clearly will in most cases not indicate local availability" is true, then Applicant implies that the claimed invention is counterproductive since it does not truly provide a customer with an available product located in his/her general vicinity. Second, there are many smaller states in which the indication of a state abbreviation does indeed indicate local availability. Applicant's argument is non-persuasive.

Applicant states, "Applicants urge that both the telephone and the light bulb provide a big convenience to anybody employing them, nevertheless they were eminent invention and clearly not obvious even in view of their extremely high convenience." (Page 18 of Applicant's Response filed October 21, 2002) The Examiner agrees that the telephone and light bulb were "eminent" inventions; however, Applicant is comparing apples and oranges. The overwhelming novelty of the telephone and the light bulb in their time have no bearing on the presently claimed invention.

Applicant argues that "NetDynamics proposes a reservation system for a local chain store, whereas the present invention addresses a product and price competitive system between a plurality of merchants" (Page 19 of Applicant's Response filed October 21, 2002). In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues, "The desirability of the steps of claim 16 are not basis for holding this steps obvious in view of the lack of teaching in both Ziff-Davis and NetDynamics" (Page 21 of Applicant's Response filed October 21, 2002). In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, this motivation to combine teachings in the rejection of claim 16 was largely based on "the knowledge generally available to one of ordinary skill in the art."

In conclusion, Applicant's arguments are non-persuasive.

All objections and rejections maintained from the previous office action (paper no. 8) are reproduced below for Applicant's convenience.

Specification

5. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 11-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Ziff-Davis Signs Up 189 Advertisers for the Coming Launch of Its Computer Shopper NetBuyer Web Site" (herein referred to as Ziff-Davis) in view of "Service Merchandise Uses NetDynamics to Move Its Entire Catalog Onto the Internet" (herein referred to as NetDynamics).

Ziff-Davis discloses a method for presenting a price comparison to a prospective buyer comprising:

[Claim 11] collecting information from a plurality of merchants relating to data concerning products and respective price information (¶ 3, 12);

storing the information into records of a database (¶ 3, 12);

sorting the information relative to products based on the database (¶ 3, 12);

presenting the information in a plurality of records to the prospective buyer (¶ 3, 12);

[Claim 12] collecting the information from sales circulars, advertised specials, sales promotions, merchants (¶ 3, 7, 12);

collecting information relating to merchant name, merchant address, product description, model number, regular price, sales price, coupons, rebates, colors, or sizes (¶ 3, 7, 12);

entering attributes into a search key (¶ 3, 12);

entering geographical region, postal code, town name, county name, state name, product name, product category, model number, product description, price, product features, or brand name into the search key (¶ 3, 12);

[Claim 13] entering attributes into a search key (¶ 3, 12);

sorting the database according to merchant name, product name or model number (¶ 3, 12);

entering data for merchants offering a specific product into the database, wherein the data includes merchant name, product description, sales price, product description, sales price, coupons or rebates (¶ 3, 6, 7, 12);

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providing access to the database through a browser interface (¶ 3 -- "web-based").

As per claim 11, Ziff-Davis does not explicitly teach that merchant products compared and presented to customers on the Internet can be ordered online and picked up from a local store; however, NetDynamics makes up for this deficiency.

NetDynamics provides the following services through their affiliates:

Included with the expanded catalog are NetDynamics applications enabling customers to check to see if a product they want is available at their local Service Merchandise store. Customers will be able to reserve the item online before visiting the store to pick it up...

Rinat explained that all of this is made possible because NetDynamics enables the development of Web applications that tie into extensive data sources. In the case of Service Merchandise, these data sources include product listings, price, and availability. NetDynamics enables Service Merchandise customers to access this information over the Internet and then to purchase it through a secure transaction. (¶ 6, 8)

Both Ziff-Davis and NetDynamics are concerned with providing a convenient Internet shopping experience to the customers; NetDynamics takes this concept one step further and fulfills many customers' need for immediate gratification (i.e., the ability to pick up a desired product from a local store). Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to implement the step of collecting information from a plurality of merchants relating to data concerning products in store locations and respective price information, wherein the prospective buyer is capable of visiting the store locations, with Ziff-Davis'

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Internet shopping system in order to reap the benefits of Ziff-Davis' product and price comparison features among multiple merchants while fulfilling many customers' need for immediate gratification (i.e., the ability to pick up a desired product from a local store).

Regarding claim 12, Ziff-Davis conveys the importance of allowing customers to search for products that meet the individual needs of each customer (§ 3, 4); however, Ziff-Davis does not expressly disclose the sorting of its product database by price. The Examiner asserts that price is often a factor taken into account when customers shop for products that meet their needs; therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to sort Ziff-Davis' product database according to price in order to allow customers to more quickly narrow down their product selections to a more reasonable set of products that are the most likely to fit their needs (including their economic needs).

As per claim 13, the Ziff-Davis-NetDynamics combination teaches the concept of comparing desired products from different merchants via the Internet, ordering products online, and then picking up the products at a local merchant (as discussed above). In order for such a system to be operational, a customer must specify his/her location so that stores truly local to the customer can be identified. The Examiner submits that the use of a state to identify one's location (thereby implying one's local region) is old and well-known in the art; therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to request that a prospective buyer specify a state in which a desired product will be searched for and then pick-up, if available, as

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part of the Ziff-Davis-NetDynamics combination in order to allow a prospective buyer to quickly learn if desired products are available for pick-up locally (instead of forcing the prospective buyer to read through useless product inventory data from stores in remotely located states). Further, the notion of sorting a database by sales price was addressed above as well; therefore, the concept of presenting products in an ascending order based on sales price (as part of the Ziff-Davis-NetDynamics combination) would also have been obvious to one of ordinary skill in the art at the time of Applicant's invention in order to allow customers to more quickly narrow down their product selections to a more reasonable set of products that are the most likely to fit their needs (including their economic needs). Finally, as discussed above, the concept of sorting data provides a convenience to someone reviewing the sorted data; therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to allow a prospective buyer to sort product data as seen fit by the buyer (e.g., based on price, merchant name, etc.) in order to facilitate a quicker review of only the most pertinent products fitting the buyer's needs.

Regarding claim 14, Ziff-Davis does not explicitly disclose the use of a unique address corresponding to a geographical area-product combination; however, the Examiner asserts that the assignment of a unique web address corresponding to a particular geographical region is old and well-known in the art. This technique is helpful in reducing Internet traffic at a given web site. Therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to map the merchant and product data (of the Ziff-Davis-NetDynamics

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combination) to a unique address and present comparison data for a unique geographical area-product pair to the prospective buyer via this unique address in order to minimize Internet traffic build-up at a given web site. This will speed up each prospective buyer's Internet connection, thereby providing a more pleasant online shopping experience.

In reference to claim 15 and as discussed above, NetDynamics teaches the steps of checking inventory at a local store of a merchant upon request of a prospective buyer to determine availability of a chosen product and reserving the product at the local store for pickup after determining availability has been performed. Again, this shopping arrangement provides for the fulfillment of many customers' need for immediate gratification (i.e., the ability to pick up a desired product from a local store). Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to implement the steps of checking inventory at a local store of a merchant upon request of a prospective buyer to determine availability of a chosen product and reserving the product at the local store for pickup after determining availability has been performed with Ziff-Davis' Internet shopping system in order to reap the benefits of Ziff-Davis' product and price comparison features among multiple merchants while fulfilling many customers' need for immediate gratification (i.e., the ability to pick up a desired product from a local store).

Regarding claim 16, both Ziff-Davis and NetDynamics facilitate the payment of an ordered product via the Internet; however, neither reference expressly teaches

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payment through the use of either a registration token or a credit card number. The Examiner asserts that it is old and well-known in the art to make payments via the Internet using either a registration token or a credit card number; therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to incorporate the use of a registration token or a credit card number to order and pay for a product via the Internet (as part of the Ziff-Davis-NetDynamics combination) in order to facilitate convenient and secure Internet payments. Further, since the Ziff-Davis-NetDynamics combination teaches the online reservation of an item before picking it up, the ability to make payment via the Internet provides extra assurance to the merchant that the reserved item will be picked up by a customer. In other words, reserved items are confirmed sales as opposed to items merely put on hold that may or may not ever be picked up and paid for by the customer.

[Claim 17] Claim 17 recites limitations already addressed by the rejection of claims 11-16 above; therefore, the same rejection applies.

[Claims 18-22] Claims 18-22 recite limitations already addressed by the rejection of claims 11-16 above; therefore, the same rejection applies.

[Claims 23-27] Claims 23-27 recite limitations already addressed by the rejection of claims 11-16 above; therefore, the same rejection applies.

Conclusion

8. This is a Request for Continued Examination. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (703) 305-1337. The examiner can normally be reached on Monday-Friday, 9 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks
Washington D.C. 20231***

or faxed to:

(703)305-7687 [Official communications; including
After Final communications labeled
"Box AF"]

(703)746-7048 [Informal/Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 22202, 7th floor receptionist.

SMD

Susanna M. Diaz
Patent Examiner
Art Unit 3623
December 27, 2002


**TARIQ R. HAFIZ
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